

## REMARKS

Claims 1-8 remain in the application for further prosecution.

### Claim Rejections - 35 U.S.C. § 103(a)

Claims 1-8 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,342,047 to Heidel ("Heidel") in view of EP 0 789 338 to Bruzzese ("Bruzzese"). The Office Action states that "[i]t would have been obvious to a person of ordinary skill the art at the time of the invention to employ the touch screen technology of Bruzzese over the non-video (electromechanical buttons) of Heidel . . ." (Office Action, page 3.) The Applicants respectfully disagree.

Three grounds are provided – any one of which is sufficient – to prove that a *prima facie* case of obviousness has not been established: (1) the proposed modification renders the reference unsatisfactory for its intended purpose, (2) the proposed modification changes the principle of operation of the reference, and (3) the references teach away from one another.

#### **The Proposed Modification Cannot Render The Prior Art Unsatisfactory For Its Intended Purpose**

To establish a *prima facie* case of obviousness, the proposed modification cannot render the prior art unsatisfactory for its intended purpose. The intended purpose of Heidel can be interpreted through its objectives and the problems it seeks to resolve.

Heidel notes that many gaming machines offer a number of different games. Heidel observes, "[i]n order to permit a machine to operate more than one game, touch screens are used so that game controls that are specific to each game can be displayed. Since video games can differ substantially in their mode of operation from game to game, it is generally not possible to use the same set of electromechanical control buttons to control different games . . . Therefore

touch screens have been used to display game controls so that a variety of games can be played on the same video lottery terminal.” (Heidel, column 1, lines 23-33.)

Heidel notes, however, that the use of touch sensitive screens for game control is *not* well received by many players because “it has been found that the display of game controls on the video display can significantly slow play in certain circumstances.” (Heidel, column 1, lines 34-36.) Heidel observes that the limitations of touch screen controls require a player “to look at the screen and to make hand movements that can be somewhat awkward, the rate of game play and hence the earning potential . . . is reduced.” (Heidel, column 1, lines 34-43.)

Electromechanical game control buttons facilitate play by touch: making game selections physically easier and speeding game play. Heidel further notes that many video poker players prefer to play the game by touch using electromechanical game control buttons – a technique that touch screen game controls do not accommodate.

To overcome the problems associated with the exclusive use of touch screen game controls, Heidel proposes to provide “a video gaming machine that is capable of playing a number of different games on a touch screen with a number of game control buttons located on the machine housing that can be used along with or instead of the touch screen to control at least one of the games.” (Heidel, column 1, lines 51-56.) This allows a gaming machine to offer multiple games; at least one of which can be played with the preferred electromechanical game control buttons.

The Office Action states that “[i]t would have been obvious to a person of ordinary skill in the art at the time of the invention to employ the touch screen technology of Bruzzese over the non-video {electromechanical buttons} of Heidel in order to make the buttons easier to operate

by making them touch sensitive.” (Office Action, page 3.) This modification, however, eliminates Heidel’s electromechanical game control buttons – essential to the operation of Heidel’s proposed invention.

To eliminate the electromechanical game control buttons required by Heidel’s invention (as described in all Heidel’s independent claims) would render Heidel unsatisfactory for its intended purpose: providing electromechanical game control buttons for at least one game in addition to using touch screen controls. Because the modification renders the prior art unsatisfactory for its intended purpose, a *prima facie* case of obviousness has not been established.

#### **The Proposed Modification Cannot Change The Principle Of Operation**

The Office Action states that “[i]t would have been obvious to a person of ordinary skill in the art at the time of the invention to employ the touch screen technology of Bruzzese over the non-video {electromechanical buttons} of Heidel in order to make the buttons easier to operate by making them touch sensitive.” (Office Action, page 3.) To establish a *prima facie* case of obviousness, however, the proposed modification of the prior art cannot change the principle of operation of the prior art being modified. This proposed modification eliminates Heidel’s electromechanical game play buttons and replaces them with touch sensitive controls – fundamentally altering Heidel’s operating principle.

Heidel’s proposed invention adds electromechanical game control buttons to standard touch sensitive game controls to allow a player to control at least one game with electromechanical buttons. Heidel states that electromechanical game control buttons improve

game play by allowing players to play by touch, which increases game speed and, thereby, the player's enjoyment of the game. (See Heidel, column 3, lines 36-39.)

Heidel's operating principle requires electromechanical game control buttons to allow a player to play by touch. The player's hand rests on the buttons, ready for the player's input. In contrast, the proposed modification – replacing the buttons with touch sensitive controls – prevents the player from playing by touch. A player cannot use a touch screen to play by touch; a player resting his hands on the touch sensitive screen creates an input signal, intended or not.

The proposed modification is a fundamental change in the principle of operation of Heidel's invention. The proposed modification, eliminating Heidel's electromechanical buttons, changes Heidel's fundamental principle of operation – allowing player input from electromechanical buttons to facilitate game play selections. Because the proposed modification changes the principle of operation of Heidel, the proposed references cannot be used to render the claims *prima facie* obvious.

### **The References Teach Away From Each Other**

Heidel observes that many gaming machines offer a number of different games. Because of the variety of such games and their game play characteristics, a single generic set of buttons is generally inadequate to serve every game. Consequently, a touch sensitive screen that can offer software programmable game play selections for each individual game is the only practical way to make gaming machines with multiple games operable.

Heidel notes, however, that the use of touch sensitive screens for game control is *not* well received by many players because “it has been found that the display of game controls on the video display can significantly slow play in certain circumstances.” (Heidel, column 1, lines 34-

36.) Heidel's solution to the problem is to use both electromechanical buttons and touch sensitive game controls; the electromechanical buttons are preferably implemented on those games most benefited from touch play. (See Heidel, column 1, lines 51-56.)

In contrast to Heidel, Bruzzese's objective is to provide "a mechanical spinning reel gaming machine that incorporates touch screen controls . . . for receiving signals from the touch screen circuitry and controlling the play of the game, including the spinning of the reels." (Bruzzese, column 1, lines 52-54.) Bruzzese's stated advantage for his proposed invention is that there will be "savings in the manufacturing unit cost of such a gaming machine because the cost of implementation of the touch screen circuitry will be less than the cabinet work, circuitry and components of the conventional button controls that are replaced." (Bruzzese, column 2, lines 19-23).

Heidel's operating principle requires electromechanical game control buttons. Bruzzese's operating principle requires the elimination of electromechanical game control buttons – substituting touch sensitive controls. Consequently, Heidel's operating principle, using electromechanical buttons to facilitate player selections in addition to touch sensitive controls, is not only incompatible with, but also antithetical to the exclusive use of touch sensitive game controls as taught by Bruzzese.

#### **No Suggestion Or Motivation To Combine Reference Teachings**

With regard to the proposed combination of Heidel in view of Bruzzese, in order for any prior art references to be validly combined for use in a prior art 103 rejection, the references themselves must suggest that they be combined. The Applicants submit that neither Heidel nor Bruzzese provide any suggestion of the advantages to be derived from the combination of their

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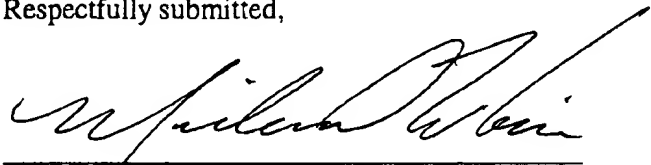
teachings, nor the desirability of making the combination, or any motivation for their combination. In fact, as shown above, Heidel not only teaches away from, but also is also antithetical to Bruzzese; consequently, providing no motivation to combine the references.

#### Conclusion

The Applicants believe the claims are in condition for allowance, and action towards that end is earnestly solicited.

If any matters may be resolved or clarified through a telephone interview, the Examiner is respectfully requested to contact the Applicants' undersigned attorney at the number shown.

Respectfully submitted,



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